

REMARKS

Claims 5, 11, 14, 35-37, and 41-46 remain pending in this application. Claims 5, 11, 14, 35, 36, and 41-45 are allowed. Claims 37 and 46 are rejected. Claims 37 and 46 are amended herein to clarify the invention. Claims 11 and 14 are amended herein for formalistic reasons.

Claims 37 and 46 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The Office Action states that the recitation of "magnetic fine particles comprise an antibody" is unclear. Applicants believe that the recitation is not indefinite since the term "comprising" is a term frequently used in patent claims and since, in light of the specification, one of ordinary skill in the art would know what is meant by such a term. However, in order to expedite the prosecution of the above-identified application, claims 37 and 46 have been amended to address the Examiner's concerns. Claims 37 and 46 are believed to be definite and Applicants therefore respectfully request that the indefiniteness rejection be withdrawn.

Claims 37 and 46 have been rejected under 35 U.S.C. § 112, first paragraph, as nonenabled. Claims 37 and 46 have been amended to recite that the antibody is bound on the surface of the magnetic fine particles. It is Applicants' position that claims 37 and 46, as amended, are properly enabled.

The Office Action states that claims 37 and 46 are not enabled because one of ordinary skill in the art understands that magnetic fine particles cannot physically

comprise an antibody. Claims 37 and 46 have been amended and such language has been removed.

The Office Action states that "[b]ecause the method of claims 41 or 42 do not include liposome coatings on the magnetic fine particles that one of ordinary skill in the art would not know how to link the antibody to the magnetic fine particle or how to make a magnetic fine particle 'comprise' an antibody."

Regarding the language of "comprise", such language has been removed.

Regarding linking the antibody to the magnetic fine particle, Applicants respectfully cite to page 8, line 9 through page 9, line 1 for disclosure regarding magnetic fine particles having an antibody on a surface thereof. In particular, the specification specifically cites to Japanese Provisional Patent Publication No. Hei. 3-128331 as teaching the binding of a magnetic fine particle and an antibody. Accordingly, it is Applicants' position that the claims, as amended, are adequately enabled.

Moreover, language directed to the presence of antibodies on the surface of magnetic particles existed in both the specification and claims as filed. The CCPA has stated that "[t]he first paragraph of § 112 requires nothing more than objective enablement" and that it is incumbent upon the Patent Office "to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence." *See In re Marzocchi and Horton*, 169 USPQ 367, 369-370 (CCPA 1971). It is Applicants' position that the

specification, as filed, adequately enables the recitation of claims 37 and 46 as evidenced, for example, on page 8 of the specification. There is no evidence that the truth or accuracy of the specification is in question and Applicants therefore respectfully request that the enablement rejection be withdrawn.

Claims 37 and 46 have been amended, support being found, for example, in the specification on page 6, lines 8-11.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

B and,

By Ricardo Unikel
Ricardo Unikel
Reg. No. 52,309
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340